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10/534,288

05/09/2005

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EXAMINER

MORILLO, JANEL COMBS

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

10/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/534,288

Applicant(s)

OBATA ET AL.

Examiner

Janelle Combs-Morillo

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6-9 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-9 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6-9, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al (US 2004/0226818 A1).

Takagi teaches a Ag-Bi sputtering target for use in a reflection film [0004], said alloy containing >0% Bi [0042] and further containing supportive elements, namely a solid solution forming element(s) including Ga, as well as intermetallic forming elements including Dy and Tm [0043], substantially as set forth in instant claims 1, 6, 9, 13-15. Takagi teaches the total supporting elements is  $\leq 2\text{at}\%$  [0044], which broadly overlaps the presently claimed additive element ranges (cl. 7, 8).

Though the instant claims are drawn to a silver alloy 'consisting of' Ag, Ga, and either Dy or Tm, because Takagi teaches said Ag alloy has an amount of Bi >0% (which includes levels on the order of ppm), said minimum is held to overlap an impurity level of Bi. The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). But see Norian Corp.

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v. Stryker Corp., 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004), see MPEP 2111.03, 'Transitional Phrases'.

Therefore, because Takagi teaches an overlapping silver alloy for use in a reflection film it is held that Takagi has created a prima facie case of obviousness of the presently claimed invention.

It would have been obvious to selected any element from the markush group of solid solution formers as well as the markush group of intermetallic formers taught by Takagi, because it is prima facie obvious to substitute equivalents known for the same purpose, see MPEP 2144.06. Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility.

3. Claims 1, 6-9, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seuntjens (US 6,294,738).

Seuntjens teaches a Ag alloy article, such as a wire, tape, or cable (column 6 line 30) said alloy including elements of Dy, Tm, and Ga (column 6 line 15-18), which broadly overlaps the presently claimed Ag alloy (cl. 1, 6, 9, 13-15).

The phrase "for use in a reflection film" as claimed is held to define merely an intended use for the alloy composition. Because the prior art teaches an alloy wire or tape (as stated above), said alloy appears to be capable of performing said intended use as recited in the preamble. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), MPEP 2111.02.

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Concerning claims 9, 14, 15, the term "sputtering target material" in the instant claim does not impart any specific physical configuration to the claimed material, and therefore the prior art product configuration is held to be as useful in sputtering targets as is the claimed material.

Concerning claims 7 and 8, Seuntjens does not mention the amount of said alloying elements. However, changes in concentration or temperature will generally not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical, i.e. they produce a new and unexpected result. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages"). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). In the instant case, the amount of alloying elements added to the alloy of Seuntjens is held to be a result effective variable, wherein the predictable result is improvement in strength properties.

Therefore, because Seuntjens teaches silver alloy with the presently claimed alloying components, it is held that Seuntjens has created a prima facie case of obviousness of the presently claimed invention.

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It would have been obvious to select any element from the Markush group taught by Seuntjens, because it is prima facie obvious to substitute equivalents known for the same purpose, see MPEP 2144.06.

### ***Response to Amendment/Arguments***

4. In the response filed on July 23, 2007 applicant amended claims 1, 6-9, and added new claims 13-15. The examiner agrees that no new matter has been added.

5. The examiner agrees applicant has overcome the rejections in view of Tauchi or JP'725 or JP'747. However, the instantly amended claims are newly rejected in view of Takagi as set forth above.

6. Applicant has not clearly shown specific unexpected results with respect to the prior art of record or criticality of the instant claimed range (wherein said results must be fully commensurate in scope with the instantly claimed ranges, etc. see MPEP 716.02 d).

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Combs-Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCM   
October 1, 2007

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